No. 90-572

IN THE

Supreme Court of the United States

OCTOBER TERM, 1990

WILSON SPORTING GOODS CO.,

Petitioner,

v.

DAVID GEOFFREY & ASSOCIATES d/b/a SLAZENGER,

and

DUNLOP SLAZENGER CORPORATION
aka DUNLOP SPORTS CORPORATION,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

RESPONDENTS' BRIEF IN OPPOSITION TO THE PETITION

DAVID B. TULCHIN
Counsel of Record
for Respondents
SULLIVAN & CROMWELL
125 Broad Street
New York, New York 10004
(212) 558-4000

JAMES H. CARTER
JOHN L. HARDIMAN
MICHAEL J. FARRELL
SULLIVAN & CROMWELL

ANTHONY M. LORUSSO
LORUSSO & LOUD
440 Commercial Street
Boston, Massachusetts 02109
(617) 227-0700
Of Counsel.

October 31, 1990

BEST AVAILABLE COPY

QUESTION PRESENTED

Wilson's contentions about the nature of the decision below in this patent infringement lawsuit (which involves the doctrine of equivalents as applied to a patent covering a particular configuration of dimples on the surface of a golf ball) are seriously inaccurate. In no way did the Federal Circuit make new law or "establish a new standard of patent infringement." Nor did that court—which has exclusive jurisdiction, nationwide, over all patent appeals—ignore or countermand this Court's holding in *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 339 U.S. 605 (1950). On the contrary, it faithfully applied that holding. The only real question before this Court is:

> Should the petition for certiorari be granted in this garden-variety patent infringement case where the United States Court of Appeals for the Federal Circuit unanimously determined as a matter of law that infringement under the doctrine of equivalents was impermissible given the facts, viewed in the light most favorable to petitioner, which established that a hypothetical literal claim sufficient in scope to cover the accused products would be invalid in light of the prior art?

The appellate decision at issue follows the long-standing black letter law that the range of equivalents claimed by the patentee cannot extend into, or be invalid in light of, the prior art.

RULE 29.1 LISTING

Please see Respondents' Motion to Seal Rule 29.1 Listing, filed concurrently herewith.

TABLE OF CONTENTS

	PAGE
QUESTION PRESENTED	i
RULE 29.1 LISTING	ii
TABLE OF AUTHORITIES	iv
STATEMENT OF THE CASE	2
1. Background	2
2. Proceedings in the Trial Court	3
3. The Federal Circuit's Decision	4
SUMMARY OF ARGUMENT	7
ARGUMENT	8
I. WILSON'S PETITION DOES NOT RAISE REASONS SUFFICIENT TO SUPPORT ISSUANCE OF THE WRIT	8
A. The Decision Below Was Fully Consistent With *Graver Tank*	9
B. Wilson's Assertion That the Appellate Court's Decision Deprives It of Its Constitutional Right to a Jury Trial Is Incorrect	11
CONCLUSION	12

TABLE OF AUTHORITIES

CASES:	PAGE
Avia Group International, Inc. v. *L.A. Gear California, Inc.*, 853 F.2d 1557 (Fed. Cir. 1988)	10
Corning Glass Works v. *Sumitomo Electric U.S.A., Inc.*, 868 F.2d 1251 (Fed. Cir. 1989)	9
General Talking Pictures Corp. v. *Western Electric Co.*, 304 U.S. 175 (1938)	10
Graham v. *John Deere Co.*, 383 U.S. 1 (1966)	10, 11
Graver Tank & Mfg. Co. v. *Linde Air Products Co.*, 339 U.S. 605 (1950)	*passim*
Loctite Corp. v. *Ultraseal Ltd.*, 781 F.2d 861 (Fed. Cir. 1985)	10
Orthokinetics, Inc. v. *Safety Travel Chairs, Inc.*, 806 F.2d 1565 (Fed. Cir. 1986)	11
Pennwalt Corp. v. *Durand-Wayland, Inc.*, 833 F.2d 931 (Fed. Cir. 1987) (in banc), *cert. denied*, 485 U.S. 981, 1009 (1988)	10
Pierce v. *Underwood*, 487 U.S. 552 (1988)	11
Railroad Co. v. *Mellon*, 104 U.S. 112 (1881)	11
Ryco, Inc. v. *Ag-Bag Corp.*, 857 F.2d 1418 (Fed. Cir. 1988)	10

PAGE

Senmed, Inc. v. *Richard-Allan Medical Industries, Inc.*, 888 F.2d 815 (Fed. Cir. 1989) 10

Under Sea Industries, Inc. v. *Dacor Corp.*, 833 F.2d 1551 (Fed. Cir. 1987) 11

Universal Gym Equipment, Inc. v. *ERWA Exercise Equipment Ltd.*, 827 F.2d 1542 (Fed. Cir. 1987) 9

STATUTES AND RULES:

28 U.S.C. § 1295(a)(1) 8

35 U.S.C. § 282 3

Sup. Ct. R. 10.1 8

OTHER AUTHORITIES:

H.R. Rep. No. 97-312, 97th Cong., 1st Sess. (1981) 8

D. Chisum, *Patents* (1990) 5, 10

E. Lipscomb, *Walker on Patents* (3d ed. 1987 & Supp. 1990) 5

No. 90-572

IN THE

Supreme Court Of The United States

OCTOBER TERM, 1990

WILSON SPORTING GOODS CO.,

Petitioner,

v.

DAVID GEOFFREY & ASSOCIATES d/b/a SLAZENGER,
and
DUNLOP SLAZENGER CORPORATION
aka DUNLOP SPORTS CORPORATION,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

RESPONDENTS' BRIEF IN OPPOSITION TO THE PETITION

There is no issue presented here which could justify a grant of the petition for a writ of certiorari to review the decision of the United States Court of Appeals for the Federal Circuit (reported at 904 F.2d 677). Petitioner's primary argument is the untenable assertion that the Federal Circuit, which handles all appeals in U.S. patent cases, flagrantly countermanded this Court's directions in its *Graver Tank* decision of 40 years ago. The three judges who unanimously ruled against petitioner below—then-Chief Judge Markey, Judge Rich and Senior Judge Cowen—have an aggregate of 98 years experience as federal judges and have each served on the Federal Circuit since its inception in 1982. The notion

that they collectively lost their senses by "overruling" *Graver Tank* is not only incredible but is based on petitioner's apparent inability to comprehend the meaning of the decision which it asks this Court to review.

STATEMENT OF THE CASE

1. Background

Petitioner Wilson Sporting Goods Company ("Wilson") holds a patent concerning the arrangement of dimples on the surface of a golf ball. The patent specifies a method of dividing the surface of the ball to form a particular six "great circles" (*i.e.*, circles that go around the widest parts of a sphere) (A1889).[1] The critical (and only meaningful) limitation of each claim of Wilson's patent is that no dimple on the ball may intersect any great circle (A1889). This characteristic—great circles that are completely dimple-free—is said to result in greater distance and accuracy of flight and was the claimed "invention."

In August 1988, Wilson filed separate suits against Dunlop Slazenger Corporation ("Dunlop") and David Geoffrey & Associates ("DGA"), alleging that each sold certain golf balls that infringed Wilson's patent (904 F.2d at 678; PA2a). The accused balls were the Maxfli Tour Limited MD (the "MD"), the Maxfli Tour Limited HT (the "HT"), and two versions of the Slazenger 480 Interlok (904 F.2d at 681; PA7a).

None of the accused balls contains the critical limitation of the patent—six dimple-free great circles. At least 60 dimples on each accused ball intersect great circles (904 F.2d at 681; PA7a).

---

[1] Citations to "A-" are to pages of the Joint Consolidated Appendix on appeal; citations to "PA-" are to pages of the appendix to Wilson's petition for certiorari.

2. Proceedings in the Trial Court

Trial of the Dunlop case was before a magistrate and jury. Because none of the accused balls contain the only critical element of the patent's claims, Wilson acknowledged the absence of literal infringement and thus sought to prove infringement under the doctrine of equivalents. At trial, Wilson's expert testified that dimples on the MD are intersected by 7.5 thousandths of an inch, and on the HT by 8.7 thousandths of an inch (A798-800, 810-13). Wilson's expert failed to specify the extent of intersection on the two 480 Interlok balls, stating only that if the diameter of the intersecting dimples were reduced by 4 thousandths of an inch *and* they were moved an unstated distance, then they would not intersect great circles (A823-24).[2]

Dunlop asserted in the district court that if the scope of Wilson's patent were permitted to extend, through the doctrine of equivalents, to the accused products, it would necessarily—and impermissibly—also cover certain prior art golf balls (*i.e.*, balls made and sold in this country before application for the patent at bar) made by Uniroyal which had intersections similar to those on Dunlop's balls. Dunlop offered into evidence a ball known as the Uniroyal Royal Master, but the magistrate excluded it at Wilson's urging (based on a completely erroneous reading of 35 U.S.C. § 282) (A1173-78).[3] The evidence about a closely related prior art ball—the Uniroyal Plus Six—came from Wilson's expert, who testified that the Plus Six contained only 30 or

---

[2] Dunlop's evidence was that the extent of intersection was 9.4 thousandths of an inch for the MD, 12.7 thousandths of an inch for the HT, and 7.8 and 9.9 thousandths of an inch, respectively, for the two versions of the 480 Interlok (A2409, 2406, 2403, 2412).

[3] On the Royal Master, the great circles were intersected by a total of 50 dimples (*see* A2571, 2412C).

more dimples that intersected great circles by approximately 12 to 15 thousandths of an inch (A901-06). Thus, although Wilson complains that "only" ten pages of testimony were devoted to the specifications of the Uniroyal ball, the evidence proving that the accused products were quite close in nature to the prior art Uniroyal ball came from Wilson itself.

The jury found, *inter alia*, infringement under the doctrine of equivalents (*i.e.*, that the accused balls were equivalent to those described in the patent's claims). On its motion for judgment notwithstanding the verdict, Dunlop argued, among other things, that infringement under the doctrine of equivalents was, as a matter of law, impermissible here because the range of equivalents required to cover the accused golf balls (*i.e.*, Dunlop golf balls with 60 slightly intersecting dimples) extended into the prior art (*i.e.*, Uniroyal golf balls with 30 or more slightly intersecting dimples). The magistrate denied that motion without even addressing Dunlop's argument in this respect.[4]

3. The Federal Circuit's Decision

In a thoughtful and unanimous opinion authored by Judge Rich and joined by then-Chief Judge Markey and Senior Circuit Judge Cowen, the Federal Circuit reversed, concluding that "a range of equivalents broad enough to cover Dunlop's balls would also have encompassed the prior art" (904 F.2d at 687; PA19a). The carefully reasoned opinion reviewed all facts in the light most favorable to Wilson (904 F.2d at 679 n.2, 681; PA5a n.2, 7a). The court thus accepted as true the testimony of Wilson's expert

---

[4] There was never any trial of the DGA case, for after the verdict against Dunlop the magistrate erroneously granted Wilson's motion for summary judgment against DGA, holding that DGA was bound by the Dunlop judgment under the doctrine of offensive collateral estoppel (A252-57).

regarding the degree of dimple intersection on the MD and HT (7.5 and 8.7 thousandths of an inch, respectively) and even characterized the degree of intersection on the 480 Interlok balls as 4.0 thousandths of an inch, despite the fact that Wilson presented no clear evidence on the point and Dunlop's testimony was that those balls had considerably greater intersections (*see* 904 F.2d at 681; PA7a; p. 3 n.2, *supra*).

The court then applied the long-standing, black letter rule of law that a patentee may not extend the range of equivalents so that it reaches into the prior art. *See* 4 D. Chisum, *Patents* § 18.04[2], at 18-97 to -98 (1990); 6 E. Lipscomb, *Walker on Patents* § 22:46, at 573 (3d ed. 1987 & Supp. 1990). The reason for this is obvious: the prior art represents matter in the public domain, and the doctrine of equivalents (which exists to prevent fraud on patents) cannot be used to expand the scope of a patent claim to ensnare that which already existed when the patent issued.

This rule of law has long been the stuff of hornbooks. *See* 4 D. Chisum, *supra*, § 18.04[2], at 18-97 to -98 ("[o]f course, it is improper to extend the range of equivalents in such a fashion that the claim in effect covers the prior art") and cases there cited; *see also* 6 E. Lipscomb, *supra*, § 22:46, at 573. Wilson's supposed surprise at seeing this rule applied to the facts established at trial by its own expert is feigned.

Further, and as the opinion below explicitly recognizes, this issue of law as to the permissible scope of equivalency is entirely distinct from the factual question of whether the patent's claims and the accused product are equivalent under *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, 339 U.S. 605 (1950). The circuit court properly stated that whether the claim and the accused product are equivalent is a factual determination to be made under the *Graver Tank* test (*i.e.*, does the accused product perform substantially the same overall function in substantially the same way, to obtain

substantially the same overall result as the claimed invention). *See* 904 F.2d at 683; PA12a. Even if this factual *Graver Tank* test of equivalency is met, infringement nevertheless is absent, as a matter of law, if to reach the accused product as an equivalent, a patent claim would also ensnare a prior art product (904 F.2d at 683; PA12a). The examination of this issue—the asserted scope of equivalency—is one of law, subject to *de novo* review, viewing the evidence in the light most favorable to Wilson (*see* 904 F.2d at 683-84; PA12a-13a).

The Federal Circuit explained the reason for this logical rule:

> [A] patentee should not be able to obtain, under the doctrine of equivalents, coverage which he could not lawfully have obtained from the PTO by literal claims. The doctrine of equivalents exists to prevent a fraud on a patent, *Graver Tank & Mfg. Co.* v. *Linde Air Prods. Co.*, 339 U.S. 605, 608, 70 S.Ct. 854, 856, 94 L.Ed. 1097 (1950), *not* to give a patentee something which he could not lawfully have obtained from the PTO had he tried. Thus, since prior art always limits what an inventor could have claimed, it limits the range of permissible equivalents of a claim.

(904 F.2d at 684; PA14a) (emphasis in original).

Wilson cannot quarrel with this long-standing rule that the prior art always limits the permissible scope of equivalency (*see* Wilson's Petition for a Writ of Certiorari ("Cert. Pet."), at 11). It thus takes issue with the court's choice of words in formulating this same test: namely, whether a hypothetical claim sufficient in scope to cover literally the accused product could have been allowed by the

patent office over the prior art had the patentee presented such a claim (904 F.2d at 684; PA14a). If not, then, as Wilson cannot deny, it is improper to permit the patentee to obtain that coverage under the doctrine of equivalents (904 F.2d at 684; PA14a). Of course, the burden of proving infringement, including the scope of equivalents, is always on the patentee (904 F.2d at 685; PA15a).

Application of these familiar principles mandated judgment for Dunlop. The literal claims of the patent specified that *no* dimple intersect *any* great circle. To ensnare the accused Dunlop balls under the doctrine of equivalents, a hypothetical claim would cover a golf ball where 60 dimples intersect great circles by about 9 thousandths of an inch. The prior art Uniroyal ball contained 30 or more intersecting dimples with only a slightly greater degree of intersection per dimple (904 F.2d at 685; PA15a-16a). As the Federal Circuit noted, these differences are so slight and minor that the hypothetical claim would have been obvious (and therefore invalid) in light of the Uniroyal ball and, hence, Wilson's patent could not as a matter of law be given a range of equivalents broad enough to encompass the accused balls (904 F.2d at 685; PA16a).

In its petition for rehearing and suggestion for rehearing in banc, Wilson argued, *inter alia*, that the Federal Circuit misapprehended the number of intersecting dimples on the prior art Uniroyal ball and that the court's opinion was contrary to *Graver Tank*. The panel that decided the appeal unanimously denied the petition for rehearing on July 5, 1990 (PA21a-22a). The suggestion for rehearing in banc was then denied by the Federal Circuit on July 26 (PA23a-24a).

SUMMARY OF ARGUMENT

The Federal Circuit's opinion herein was not in any way contrary to *Graver Tank*. This case turned on an issue not

even before the Court in *Graver Tank*: whether the claims of a patent may be extended by the doctrine of equivalents to ensnare a device that existed in, or was obvious in light of, the prior art. Far from making new law, the Federal Circuit followed a long line of cases which holds that the doctrine of equivalents cannot be used to extend patent claims into the sphere of the prior art. There are thus no special or important reasons for review.

ARGUMENT

I.

WILSON'S PETITION DOES NOT RAISE REASONS SUFFICIENT TO SUPPORT ISSUANCE OF THE WRIT

Wilson fails even to acknowledge that issuance of a writ of certiorari is appropriate only upon a showing of "special and important reasons" for this Court's review. Sup. Ct. R. 10.1. There are no such reasons here.

Indeed, Wilson's petition is based primarily on the completely erroneous contention that the Federal Circuit failed to understand and follow this Court's *Graver Tank* decision of 1950—perhaps the best known patent decision of modern times. The Federal Circuit, which has exclusive appellate jurisdiction in all patent cases, 28 U.S.C. § 1295(a)(1), was established, among other reasons, to promote a uniform national patent law and to place appellate review of complex and technically challenging patent cases in one court, composed of judges who are acknowledged experts in the field. *See* H.R. Rep. No. 97-312, 97th Cong., 1st Sess. 20-23 (1981). Not surprisingly, it is Wilson, not our national appellate patent court, which grossly misconstrues *Graver Tank*.

A. The Decision Below Was Fully Consistent With *Graver Tank*.

Graver Tank established the standards for determining whether an accused product is equivalent, as a matter of fact, to the claims of a patent. In the case at bar, the issue of law which the Federal Circuit found to be dispositive was whether a patent should be accorded a scope under the doctrine of equivalents which it could not have obtained in the first instance from the patent office. These two questions—the *determination* of equivalency between patent claim and accused product as fact and the permissible *scope* of equivalency under law—are entirely distinct. *Graver Tank* addressed only the former, holding that the determination of equivalency (which may include an examination of the prior art) is an issue of fact. Wilson's confusion stems from its refusal to recognize the difference in these two questions.

The Federal Circuit has without exception followed *Graver Tank*, holding that the determination of equivalency is a question of fact.[5] *See, e.g., Corning Glass Works* v. *Sumitomo Electric U.S.A., Inc.*, 868 F.2d 1251, 1261 (Fed. Cir. 1989) (quoting *Graver Tank*); *Universal Gym Equipment, Inc.* v. *ERWA Exercise Equipment Ltd.*, 827 F.2d 1542, 1548 (Fed. Cir. 1987). With as much consistency, the Federal Circuit has held that the permissible *scope* of equivalency is

---

[5] The Federal Circuit's decision here did not rest on the factual determination of equivalency. After acknowledging that "[i]nfringement *may* be found under the doctrine of equivalents if an accused product" meets *Graver Tank*'s three-part test of substantially similar function, means and result (904 F.2d at 683; PA12a) (emphasis in original), the court held that infringement cannot be found as a matter of law if the asserted *scope* of equivalency would encompass the prior art (904 F.2d at 683; PA12a).

limited by the prior art.[6] *Senmed, Inc.* v. *Richard-Allan Medical Industries, Inc.*, 888 F.2d 815, 821 (Fed. Cir. 1989); *Ryco, Inc.* v. *Ag-Bag Corp.*, 857 F.2d 1418, 1426 (Fed. Cir. 1988); *Pennwalt Corp.* v. *Durand-Wayland, Inc.*, 833 F.2d 931, 934 n.1 (Fed. Cir. 1987) (in banc), *cert. denied*, 485 U.S. 981, 1009 (1988); *see* 4 D. Chisum, *supra*, § 18.04[2], at 18-97 to -98.

Further, the court's holding that the scope of equivalents is a question of law subject to *de novo* review is also firmly supported by precedent.[7] *Loctite Corp.* v. *Ultraseal Ltd.*, 781 F.2d 861, 870 (Fed. Cir. 1985). No court has deviated from this rule.

These points dispose completely of the idea that the court below broke new ground or improperly deviated from this Court's holdings. Wilson's remaining assertion, namely that the Federal Circuit improperly applied the law to the facts (viewed in the light most favorable to Wilson), raises no *cert*-worthy issue, *cf. General Talking Pictures Corp. v. Western Electric Co.*, 304 U.S. 175, 178 (1938) ("[g]ranting of the writ would not be warranted merely to review the evidence or inferences drawn from it"), and is in any event far off base. The record fully supports a finding that 30 dimples on the Uniroyal Plus Six ball intersected great circles (*see* 904 F.2d at 685; PA16a), and Wilson's argument to the

---

[6] In the decision below, the Court used the hypothetical claim analysis to "permit[] a more precise analysis" of the limitation on scope (904 F.2d at 684; PA14a-15a). Thus, far from fashioning a new rule, the court simply re-stated, in other words, a test that was well-developed in its jurisprudence.

[7] This is unsurprising, given that the closely related question of claim validity in view of the prior art is also one of law. *Graham* v. *John Deere Co.*, 383 U.S. 1, 17 (1966); *Avia Group International, Inc.* v. *L.A. Gear California, Inc.*, 853 F.2d 1557, 1562 (Fed. Cir. 1988).

contrary formed the basis for its motion for rehearing, which the court below properly denied.

B. Wilson's Assertion That the Appellate Court's Decision Deprives It of Its Constitutional Right to a Jury Trial Is Incorrect.

Wilson's argument that, even under the lower court's hypothetical claim analysis, issues bearing on obviousness must be determined by the fact-finder under *Graham* v. *John Deere Co.*, 383 U.S. 1, 17-18 (1966) is wrong. First, *John Deere*—which, consistent with the lower court's approach, holds that "the ultimate question of patent validity is one of law," 383 U.S. at 17—addressed only whether the literal language of a patent claim was valid and never considered any questions under the doctrine of equivalents. *See* 383 U.S. at 4-5. Second, as explained above (p. 4, *supra*), the Federal Circuit here viewed all factual issues in the light most favorable to Wilson. In short, Wilson *had* its jury trial and failed to present evidence sufficient to sustain a legal conclusion that its patent could have a range of equivalents that would cover the accused products without extending into, or being rendered obvious by, the prior art.[8]

Questions of law may of course be reviewed by appellate judges. *See Pierce* v. *Underwood*, 487 U.S. 552, 558 (1988).

---

[8] Wilson is incorrect in asserting (*see* Cert. Pet., at 15) that the Federal Circuit misallocated the burden of proof in requiring the patentee to show that the scope of equivalents it claims would not have been invalid in light of the prior art. The patentee always bears the burden of proving infringement. *See Railroad Co.* v. *Mellon*, 104 U.S. 112, 119 (1881); *Under Sea Industries, Inc.* v. *Dacor Corp.*, 833 F.2d 1551, 1557 (Fed. Cir. 1987). *Orthokinetics, Inc.* v. *Safety Travel Chairs, Inc.*, 806 F.2d 1565 (Fed. Cir. 1986), is not to the contrary. It did not even concern the issue of infringement; it addressed the issue of patent validity. *See* 806 F.2d at 1570-71.

Wilson's argument that its constitutional right to trial by jury was abrogated by the appellate court's review of a question of law is even more far-fetched than its assertion that Chief Judge Markey and his esteemed colleagues *sub silentio* overruled *Graver Tank* and the ensuing forty years of patent law jurisprudence.

CONCLUSION

Wilson mischaracterizes the decision below, which made no new law and is fully consistent with long-standing precedent. In any event, there is no issue sufficient to support issuance of a writ of certiorari. The petition should be denied.

Respectfully submitted,

DAVID B. TULCHIN
Counsel of Record
for Respondents
SULLIVAN & CROMWELL
125 Broad Street
New York, N.Y. 10004
(212) 558-4000

JAMES H. CARTER
JOHN L. HARDIMAN
MICHAEL J. FARRELL
SULLIVAN & CROMWELL

ANTHONY M. LORUSSO
LORUSSO & LOUD
440 Commercial Street
Boston, Mass. 02109
(617) 227-0700
Of Counsel.

October 31, 1990